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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,134	09/08/2003	Valerie De La Poterie	230251US0	8666

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1619

NOTIFICATION DATE	DELIVERY MODE
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11/12/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/656,134	<b>Applicant(s)</b> DE LA POTERIE ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 31-34, 36, 37, 39-53, 55 and 62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-34, 36-37, 39-53, 55 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt is acknowledged of remarks filed on 6/25/09. Claim 38 has been cancelled as per applicants' amendment dated 6/25/09.

#### **Status of claims**

Claims 1-30, 35, 38, 54 and 56 are cancelled. Claims 57-61 have been withdrawn from consideration as being drawn to non-elected subject matter. Claims 31-34, 36-37, 39-53, 55 and 62 are currently examined in the application.

#### ***Claim Rejections - 35 USC § 112***

Claims 31-34, 36-53, 55 and 62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

The specification at page 47 teaches mascara composition meeting claim requirement of exhibiting solids content defined by a dry solid extracts of more than 45% by weight. This composition has structuring agent which is a combination stearyl acrylate /N-vinyl pyrrolidone and polybutene (combination of specific compound and oil) . Specification describes various polymers as specific compounds and various oils. Specification also teaches at pages 27-30 measurement protocol for tack value, solid extract, hardness value and consistency index. Only the composition in example at page 47 exhibits the claimed dry solid extract of more than 45 % by weight. However, claims 31-34 , 36 -46 , 53 and 62 are directed to compositions which have the structuring agent and no waxes. The composition claimed in claims 31-34 , 36 -46, 53 and

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62 encompass plethora polymers belonging to specific compounds and various oils belonging to oils such as the combination of specific compound and oil are chosen such that the composition exhibits solid content defined by a dry solid extract of more than 45 % by weight. Specification does not teach any other composition exhibiting the solid content defined by a dry solid extract of more than 45 % by weight other than the example at page 47. **The specification provides insufficient written description to support the genus encompassed by the claims.**

The specification at page 47 teaches mascara composition meeting claim requirement of exhibiting solids content defined by a dry solid extracts of more than 45% by weight. This composition has structuring agent which is a combination stearyl acrylate /N-vinyl pyrrolidone and polybutene (combination of specific compound and oil) . Specification describes various polymers as specific compounds and various oils. Specification also teaches at pages 27-30 measurement protocol for tack value, solid extract, hardness value and consistency index. Only the composition in example at page 47 exhibits the claimed dry solid extract of more than 45 % by weight. However, claims 47-52 and 55 are directed to compositions which have the combination of structuring agent and film forming polymer and no waxes. The composition claimed in claims 47-52 and 55 encompass plethora polymers belonging to specific compounds and various oils belonging to oils such that the combination of specific compound and oil and numerous polymers belonging to film formers are chosen such that the **composition** exhibits solid content defined by a dry solid extract of more than 45 % by weight. Specification does not teach any other composition other than mascara composition. Composition can be lipstick composition, or nail polish composition or eye-make up composition or foundation composition. Specification does not teach all these compositions exhibiting the solid content defined by a dry

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solid extract of more than 45 % by weight other than the example at page 47. **The specification provides insufficient written description to support the genus encompassed by the claims.**

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which structuring agent would possess the property described in claims 31-34, 36-37 and 47. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The composition itself is required. See *Fiefs v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: ...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written

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description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood , 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the structuring agent shown at page 47 shown to possess to required property described in claims 31-34, 36-37 and 47 meet the written description provision of 35 USC § 112, first paragraph. The specification does not teach any of the named structuring agent actually exhibiting solid content defined by dry solid extracts of more than 45 % by weight and thus what is disclosed is not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115.)

### ***Response to Arguments***

Applicant's arguments filed 6/25/09 have been fully considered but they are not persuasive.

Applicants' argue that specification at paragraphs[001, 0020, 0030, 0034, 0036-0040, 0044-0047, 0051] describe dry solids by weight, structuring agent and oil and thus argue that one skilled in the art would recognize that the primary purpose of the invention was to provide a wax-free composition with high solid content and a structuring agent composed of a compound and oil and thus comply with written description rejection.

In response to the above argument, specification describes structuring agent and oil and wax free compositions. However claim 31 recite the functional language wherein the composition, which is wax-free in the form of mascara and having in the composition a fatty

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phase and the fatty phase has structuring agent (semi-crystalline polymers or rheological agents) and at least one oil and this composition **exhibits a solid content defined by dry solid extract of more than 45 % by weight.** See below for claim 31.

*31. (Currently Amended): A composition comprising at least one fatty phase, said fatty phase comprising at least one structuring agent consisting of the combination of at least one specific compound selected from the group consisting of semi-crystalline polymers; fatty-phase rheological agents; and mixtures thereof; and at least one oil, **said composition comprising no waxes and exhibiting a solids content defined by a dry solids extract of more than 45% by weight**, wherein the fatty phase represents from 10 to 60% of the total weight of the composition, and wherein said composition is a mascara.*

Specification at page 30 describes solid content measurement protocol. See below for the protocol.

*Solids content measurement protocol*

*This consists of a measurement of the dry extract of the mascara liquor, which is carried out on a Mettler Toledo HG 53 balance halogen moisture analyser).*

*A sample of mascara (2-3 g) is deposited on an aluminium dish and subjected to a temperature of 120°C for 60 minutes. The measurement of the dry extract corresponds to the monitoring of the mass of the sample over time. The final solids content is therefore the percentage of the final mass (after 60 min) in relation to the initial mass:  $DE = (final\ mass / initial\ mass) \times 100$ .*

Specification at page 47 describes combination of stearyl acrylate/N-vinylpyrrolidone copolymer and polybutene oil exhibiting solid content of 56.8%. specification does not describe

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any other combination of semi-crystalline polymer and oil exhibiting solid content of greater than 45 % by weight since one copolymer is not representative of all the semi-crystalline polymers. Specification describes various semi-crystalline polymers at pages 13-22. These polymers include block polymers or copolymers , homopolymers or copolymers carrying at least one crystallizable chain or block.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984). Accordingly, describing one composition which describes the combination one semi-crystalline polymer and oil is not representative of the genus and one skilled in the art would not recognize from the disclosure that the applicant was in possession of the genus drawn to composition of claim 31.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619